



DAF 762
IFW
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

David A. KRITLER et al

Art Unit: 1762

Application No: 10/055,165

Examiner:

Filed: January 21, 2002

For: APPARATUS AND METHOD FOR PREPARING
A COATED OPTICAL FIBER

PETITION FOR RETROACTIVE LICENSE UNDER 37 CFR 5.25
PRINCIPAL PETITION

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Attention: Director of Technology Center 3640

Sir:

Applicant petitions for a retroactive license under 35 USC 184 to permit filing of foreign patent applications corresponding to this U.S. patent application.

The unlicensed patent application material has been filed in the European Patent Office.

The date on which the material was filed in the European Patent Office is March 15, 2002.

A verified statement under 37 CFR 5.25(a)(3) is submitted herewith. It is believed that this statement shows that the material was filed abroad through error and without deceptive intention without the required license first having been obtained.

A check in the amount of \$130 for the fee under 37 CFR 1.17(h) is enclosed.

08/09/2004 SFELEKE1 00000088 10055165

01 FC:1460

130.00 DP

ALTERNATIVE PETITION

In the event that the principal petition is considered insufficient, it is requested that the license that was granted on March 19, 2002 be deemed to have been granted with effect from prior to March 15, 2002.

Respectfully submitted,



John Smith-Hill
Reg. No. 27,730

SMITH-HILL & BEDELL, P.C.
12670 NW Barnes Road, Suite 104
Portland, Oregon 97229

Tel. (503) 574-3100
Fax (503) 574-3197
Docket: NETT 2207
Postcard: 08/04-10

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the

6th day of August, 2004





PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

David A. KRITLER et al

Art Unit: 1762

Application No: 10/055,165

Examiner:

Filed: January 21, 2002

For: APPARATUS AND METHOD FOR PREPARING A
COATED OPTICAL FIBER

STATEMENT UNDER 37 CFR 5.25(a)(3)

I, John Smith-Hill, declare as follows:

1. During the period ending on January 21, 2002, I prepared a specification (description and claims) and drawings for filing at the Patent and Trademark Office in connection with a regular U.S. patent application claiming benefit of Provisional Application No. 60/276,393 filed March 16, 2001. The regular application was filed on January 21, 2002 as Patent Application No. 10/055,165.

2. On March 7, 2002, I sent an order letter by email to a European associate with copies of the specification and drawings that I had prepared for the regular U.S. patent application and I instructed the associate to file a European patent application based on the attached specification and drawings no later than March 16, 2002. The subject matter described in the U.S. patent application and in the counterpart European patent application was not under a secrecy order at the time it was filed in the European Patent Office and is not currently under a secrecy order. In fact, a foreign filing license was granted on March 19, 2002 for the regular U.S. patent application and a foreign filing license was granted on June 26, 2001 for the provisional application.

3. On July 31, 2004, during a routine review of correspondence relating to a reply to an Office Action in a related application, I realized that I should have requested a license under 35 USC 184 prior to initiating filing of the European patent application.

4. I had initially received instructions on September 21, 2001 to file the regular U.S. patent application claiming benefit of Provisional Application No. 60/276,393.

5. My file notes do not show when I received instructions to file the European patent application. My standard procedure is to request instructions for possible foreign filing four months before the due date (at the same time as I request instructions for filing the regular patent application following a provisional application), which would have been November 16, 2001, but since I had received instructions to file the regular application on September 21, 2001, and the European patent application was not filed until March 2002, I conclude that I did not receive instructions to file the European patent application at that time.

6. I believe that I received instructions to file the European application on or just a day or two before March 7, 2002 and in view of the short time remaining before the deadline of March 16, 2002, I immediately sent filing instructions to the European associate. My belief regarding the time at which I received instructions is supported by the fact that I sent the filing instructions to the European associate by email rather than by regular mail.

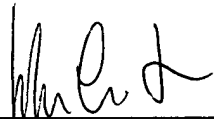
7. In the circumstances, I believe that urgency of the need to send instructions to the European associate forced my awareness of the need to obtain a foreign filing license from my attention. Had I recalled that a foreign filing license was necessary, I would not have sent instructions to my European associate and I would instead have advised my client to file an International application designating European Patent Office. Immediately after realizing that the license was necessary, and that no license had been obtained, I initiated preparation and filing of a request for a retroactive license under 37 CFR 5.25.

8. During the eight years prior to March 7, 2002, I filed numerous foreign patent application, but, to the best of my recollection, in each case the foreign application did not contain any material in addition to that contained in a corresponding regular U.S. application filed almost a year before and a foreign filing license had been granted as shown on the official filing receipt. Consequently, I had become insensitive to the foreign filing license requirement in the specific case, which is unusual in my practice, of

a foreign application that contains material in addition to that disclosed in the U.S. application from which priority is claimed.

9. In April 2004, I instructed my assistant to include, as the first item in the checklist of foreign filing procedures, a explicit check as to whether a license is required. I am confident that this additional check will guard against a repetition of the events in this case.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, Sec. 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



John Smith-Hill
8/6/04

Date